

4,700,065 to Kordulla et. al. (Kordulla), U.S. Patent No. 4,620,094 to Tani et. al. (Tani), and U.S. Patent No. 4,103,155 to Clark (Clark). The Examiner has rejected claims 5 and 7, under 35 U.S.C. §103(a), as being unpatentable over Nakamura in view of Yoshikawa, Bruch, Kordulla, Tani and Clark, as applied to claim 1, and further in view of U.S. Patent No. 4,369,578 to Ernst (Ernst). It is respectfully submitted that all of the claims presently pending in the application are patentably distinct over the prior art, including all of the prior art of record in the application, and are, therefore, allowable. The combination of the cited prior art does not lead to the claimed invention nor does such a combination provide the advantages of the invention.

Nakamura shows a probe of a scanning device for a position measuring system. The probe is operatively connected with a scale graduation and is supplied with electrical power over a plurality of electrical connections. There is also an electric module coupled to the probe. Nakamura, however, fails to disclose housing parts with part of the probe outside the housing, a fuse of lower melting point that interrupts current at a specific temperature, a sectional constriction, and parts of electrical connections extending outside the housing.

Yoshikawa shows a melting fuse. This melting fuse has a sectional constriction in a conductor. Yoshikawa's device has its own housing, as a separate part. The fuse, in accordance with the invention, is integrated into the conductor strips the electrical connections are made of, and the housing of the fuse is the housing of the electronic module. The housing and the conductor strips have a double function that reduces the cost of the system: The housing is the housing of the electronic module and the housing of the fuse(s), the conductor strips supply current to the probe and build up the fuses.

Bruch only suggests the application of fuses in hazardous environments, but does not provide a detailed description. The fuse, in Bruch, is not placed in the electrical connection between the electric module and the probe, it is placed at the input side of the electronic module.

Cordulla shows an optical encoder with LEDs in housing 14 and a photodiode (the probe) 40 in housing 16. The probe in Cordulla is completely inside the housing.

Tani shows an optical encoder like the encoder shown in Cordulla. Parts of the probe are disposed outside of the housing but no electrical connections supplying current to the probe are exposed outside the housing.

Clark shows an encoder with a conventional housing 28. All parts of the probe are inside the housing. The encoder is connected to other equipment by cable 26. The cable 26 is exposed outside the housing, as any cable connected to a housing is exposed to the outside of such a housing, but it does not comprise conductor strips.

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggesting supporting the combination. Under section 103, teachings of references can be combined only if there is some suggesting or incentive to do so.”

In re Fritch, 23 U.S.P.Q. 2d 1780, 1783 (Fed. Cir 1992) (footnote omitted) (emphasis in original).

See also *In re Sernaker*, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); *SmithKline Diagnostics, Inc. v. Helena Laboratories Corp.*, 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); *In re Laskowski*, 10 U.S.P.Q. 2d 1397, 1399 (Fed. Cir. 1989); *In re Fine*, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The Court of Appeals for the Federal Court clearly stated:

It is impermissible to use the claimed invention as an instruction manual or "template" to piece together the teaching of the prior art so that the claimed invention is rendered obvious.

In re Fritch, 23 U.S.P.Q. 2d 1780, 23 1780, 1783 (Fed. Cir. 1992)

The In re Fritch holding only confirmed a long established view that obviousness should not be read "into an invention on the basis of Applicant's own statements". The prior art must be viewed "without reading into that art Appellant's teachings" and the teachings of the prior art should, "in and of themselves and without the benefits of Appellant's disclosure (emphasis in the original text) make the invention as a whole, obvious." In re Spinnoble, 160 U.S.P.Q. 237, 243 (CPA 1969).

There is no suggestion, incentive or motivation in the cited reference for the combination on which the Office Action relies. A statement that it would have been obvious to one skilled in the art to make modifications to the references is not sufficient to establish a *prima facie* case of obviousness. MPEP § 2143.01 relying on Ex Parte Levengood, 28 U.S.P.Q. 2d 1300 (Bd. Pat. App. & Inter. 1993). The Federal Circuit has held that a claimed invention was not obvious, where "[c]onspicuously missing from [the] record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one skilled in the art would have been motivated to make the modification of the prior art "necessary to arrive at the claimed invention." In re Jones 21 U.S.P.Q. 2d 1941 (Fed. Cir. 1992).

Ex Parte Clapp, 227 USPQ 972,973 (Bd. Pat. App & Inter. 1985) requires that when the references do not suggest the invention "... the Examiner must present a convincing line of reasoning

as to why the artisan would have found the claimed invention to have been obvious in light of the teaching of the references.” No such line of reasoning is seen in the Office Action.

There is no suggestion in the cited prior art that would lead one of ordinary skill in the art to attempt a combination of these references to achieve the invention as claimed in claim 1. Claims 3-5 and 7-9 depend on claim 1 and are allowable for the same reasons claim 1 is allowable and further because of specific features recited therein which, when taken alone and/or in combination with the features recited in claim 1, are not disclosed or suggested in the prior art.

CONCLUSION

In view of the foregoing, it is respectfully submitted that the application is in condition for allowance, and allowance of the application is respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects, in order to place the case in condition for final allowance, then it is respectfully requested that such amendment or correction be carried out by Examiner's amendment and the case passed to issue.

Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, the Examiner is invited to telephone the undersigned.

Respectfully Submitted,



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I hereby certify that this correspondence is being deposited with the United States Postal Service as first class mail and addressed to: Commissioner for Patents, Alexandria, VA 22313-1450 on June 17, 2003.

